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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,945	11/26/2003	John J. Price	97017-00169 (ETH-5089)	9633

7590 10/30/2006

Ralph W. Selitto, Jr.
McCarter & English, LLP
Four Gateway Center
100 Mulberry Street
Newark, NJ 07102

EXAMINER	
TYSON, MELANIE RUANO	
ART UNIT	**PAPER NUMBER**
3731	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/722,945	PRICE, JOHN J.	
	Examiner	Art Unit	
	Melanie Tyson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *13 and 15-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, Species 1, in the reply filed on 10 October 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 13 and 15-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Proto (Patent No. 6,056,771). Proto discloses an armed suture (Figure 7) comprising a needle (22), a suture hole (32), a monofilament suture (42; column 5, line 24), and an adhesive bonding (cyanoacrylate; column 5, lines 28-30). It is inherent that the adhesive has a viscosity permitting the suture to be inserted into the suture hole since it is well known that adhesives, such as cyanoacrylate, are in a liquid form until they dry.

Claims 2-3 and 5-8 are being treated as product by process limitations, in that "said adhesive is curable by exposure to magnetic radiation" and "said adhesive is curable by a second curative agent" refer to the process of curing the adhesive and not

to the final product created. As set forth in MPEP 2113, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985). Examiner has evaluated the product claims without giving much weight to the method of its manufacture. Therefore, in this case, an armed suture as described above wherein the adhesive is curable by exposure to electromagnetic radiation and by a second curative agent is directed to the method of making the armed suture and not to the final product made. It appears that the product disclosed by Proto would be the same or similar as that claimed; especially since both applicant's product and the prior art product have the same final structure of an armed suture comprising a needle, a suture hole, a suture, and an adhesive bonding.

4. Claims 1 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Morton (Patent No. 1,558,037). Morton discloses an armed suture (Figure 3) comprising a needle (1) having a swaged end (3; page 1, lines 50-52), a suture hole (2), a suture (4), and an adhesive bonding (adhesive in liquid form; page 1, lines 32-35). The suture hole has a first (top of hole) and second (bottom of hole) diameter, wherein the second diameter is greater than the first diameter (page 1, lines 27-31), such that the adhesive forms an interlock with the needle hole (see Figure 3 and page 2, lines 34-40).

Morton further discloses that the suture hole is drilled (page 2, lines 19-51),

which inherently leaves an unfinished suture hole (2). Since Morton discloses placing an adhesive in the suture hole (2) without polishing the suture hole (2), it is inherent that the suture hole (2) of Morton is unpolished.

Claim 11 is being treated as a product by process limitation, in that "said suture hole is formed by laser drilling" refers to the process of forming the suture hole and not to the final product created. As set forth in MPEP 2113, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985). Examiner has evaluated the product claim without giving much weight to the method of its manufacture. Therefore, in this case, an armed suture as described above wherein the suture hole is formed by laser drilling is directed to the method of making the armed suture and not to the final product made. It appears that the product disclosed by Morton would be the same or similar as that claimed; especially since both applicant's product and the prior art product have the same final structure of an armed suture comprising a needle, a suture hole having a first and second diameter, a suture, and an adhesive bonding.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571) 272-

9062. The examiner can normally be reached on Monday through Thursday 9:00 a.m. - 6:30 p.m., alternate Fridays 9:00 a.m. - 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson MT
October 23, 2006

ANHTUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
10/20/06